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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,907	12/22/2000	Takahiro Endo	1344.1052 (JDH)	6594
21171	7590	08/28/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/741,907

Applicant(s)

ENDO ET AL.

Examiner

Yehdega Retta

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1,2,4-9,11-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed June 13, 2006. Applicant amended claims 1, 4, 6, 8, 9, 11, 13, 15, 17, 19 and 21-24 and canceled claims 3,10 and 16. Claims 1, 2, 4-9, 11-15 and 17-24 are still pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-9, 11-15 and 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Based on the interpretation stated below, the specification does not teach the providing target (recipient) is preliminarily determined by the advertisement provider. As stated below the specification teaches the advertisement provider inputting advertisement information such as target generation, target region, target sex, etc. This however does not imply that the advertisement provider determines who the recipient is. As best understood by the examiner the specification teaches the advertiser entering a target profile, which indicates what type of consumer should receive the advertisement, and based on the input preference trend the advertisement for the recipient is selected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-9, 11-15 and 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant new amended the claims and replaced the term “addressee” with the term “providing target”. According to Applicant’s specification the card is send to an addressee and the advertisement provider, as also argued by Applicant, determines a target “market” not the particular addressee. Furthermore, the specification discloses (page 11) “At this time, since for each piece of advertisement information the target generation, target region, target sex, target field, target occupation and the like are registered, a consumer as a target of advertisement providing, can be effectively selected, and hence effective publicizing by the advertisement information can be performed. Thus, in one embodiment, a consumer target of the advertisement who has been preliminarily determined by the advertisement provider can be effectively selected”. Applicant by claiming the card being sent to providing target (a recipient) and also claiming the providing target being preliminarily determined by the advertisement provider creates confusion, since it is unclear whether applicant is referring the “addressee” (recipient) or the target audience (the group the recipient fall within). Nowhere in the specification does it indicate what the providing target is. Further the specification does not indicate that the advertisement provider determines the recipient of the card. According to applicant’s disclosure the sender of the card determines who the recipient (addressee) is and the advertisement provider determines target and the advertisement is selected based on the

preference of the recipient. Applicant is required to clearly indicate the interpretation of the “providing target” in light of the specification.

Claims 1 and 21 recite the limitation “said sending client”. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 24 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stanbach et al. (US 6,449,657).

Regarding claim 24, Stanbach teaches inputting preference trends of an addressee (providing target), selecting an advertisement to fit the preference trends including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of said addressee

(providing target), associating the advertisement with a card; and sending card to the addressee (providing target) (see col. 9 line 55 to col. 10 line 14, col. 11 lines 10-22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. JP 11-242714 further in view of Stanbach, Jr. et al. (US 6,449,657).

Regarding claims 1, 2, 4-7, Sugimoto teaches means for sending a card attached with an optional message to a specified addressee (providing target);; means for inputting a preference trends of addressee (providing target), and means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; means for selecting advertisements suitable for the preference trends of addressee; and means for selecting advertisements suitable for the preference trends of sender; means for making the card sending client select one piece of advertisement from the plurality of advertisement displayed; storing card sending history; frequency counting means; means for sending card attached with the advertisement ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto does not specifically teach wherein

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the providing target (target audience or criteria) is preliminary determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064)) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3).

Regarding claims 8, 9, 11-14, Sugimoto teaches means for sending card attached with optional message to specified addressee; means for inputting preference trends; means for selecting advertisement; means for presenting advertisement; selecting advertisement information suitable for the addressee; selecting advertisement information suitable for the sender; selecting and presenting plurality of advertisements; card sending client select one of the advertisement; a card sending history; changing additional information ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information\_ (see pp. 16 lines 24-

32 (par. 2), pp. 17 par. 2&3). and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto does not specifically teach wherein the providing target (target audience or criteria) is preliminary determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064)) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3).

Claims 15, 17-20 are rejected as stated above in claims 8-15.

Regarding claims 21-23, Sugimoto teaches sending a card attached with an optional message to a specified addressee; input preference trends of the addressee; selecting advertisement information to fit the preference trends of the addressee and adding the advertisement information; inputting preference trends of sender; selecting advertisement to fit the sender's preference trends and presenting the advertisement to sending client (see pp. 10-11,



13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient filled out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto does not specifically teach wherein the providing target (target audience or target criteria or as indicated by applicant's argument "a target market") is preliminary determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3).

### ***Response to Arguments***

Applicant's arguments filed June 13, 2006 have been fully considered but they are not persuasive. Regarding claim 24, applicant argues that the Stanbach reference does not teach

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selecting advertisement to fit the preference trend of said providing target. Applicant asserts that the advertisement selection of Stanbach is based on demographic. As indicated above Stanbach teaches the demographic profile including user lifestyle preference and favorites (see col. 11 lines 10-22, col. 19 lines 4-14 and figure 10 table 1064). Therefore, the advertisement is selected based on the preference (lifestyle preference and favorites) of the recipient (providing target).

In regard to claim 1-23, applicant argues that in contrast to both Sugimoto and Stanbach, a prospective providing target is determined preliminarily by the advertisement provider for presentation to the card-sending client, upon selection of suitable advertising information. Applicant further asserts that the card-sending client, then, is presented with or indicated a plurality of advertising information which might be appropriate and selects one of the to forward to providing target. Applicant then states that several examples of providing targets are described in the last paragraph at page 10 of the specification. Applicant also states in the claimed invention, an advertisement provider can provide the advertisements to **a target market**.

The last paragraph of page 10 discloses the following:

In step 21, an advertisement information registration screen 54 such as shown in FIG. 15 is displayed on the terminals 20b and 20c of the advertiser. The advertisement information registration screen 54 comprises an input section for inputting advertisement provider ID, password, and **provider advertisement information**, a "register" button, and a "cancel" button. Here "**provider advertisement information**" means various information which specify advertisement information such as; advertisement ID, data name, target generation, target region, target sex, target field, target occupation, discount unit, discount rate, advertisement number, limit, and period. On page 11 of the specification last paragraph, it is

stated “(a)t this time, since for each piece of advertisement information the target generation, target region, target sex, target field, target occupation, and the likes are registered, a consumer as a target of advertisement providing, can be effectively selected, and hence effective publicizing by the advertisement information can be performed. The Examiner understanding is that the advertisement provider determines a target market, as stated by Applicant. That is what kind of consumer should be targeted with a particular advertisement is determined by the advertisement provider. In the specification however, it is clear, the card sending service sends card to an addressee specified by the sending client and the preference trend of the addressee is also entered. Therefore, there is a difference between the addressee and the target market. However as it is claimed the recipient of the card and what the advertisement provider determines is the same. Applicant stresses that no providing target is mentioned in either Sugimoto or Stanbach at al. For that matter nowhere in applicant’s disclosure is mentioned a providing target. Since there is a misunderstanding of the claimed invention the rejection of 112 above is applied. Examiner is using two different meaning for the term “providing target”, an *addressee* and a *target market*. Stanbach teaches the advertisement provider determining the target audience, such as the target age, target sex, target income, for the advertisement, same as applicants invention (see col. 12 lines 39-55).

Applicant also argues that Sugimoto pays no attention to what the preference trends of the providing target might be at all, let alone selects advertising information based upon them. Contrary to applicant’s argument Sugimoto teaches the client (sender and recipient) filling a questionnaire of several “courses” sponsored by different advertisers (see page 4) offering the gifts (see page 5) used for selecting gifts by the sender. Sugimoto teaches sender selects a

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specific course; the sender can also receive a gift selected by the advertising company paying for this course, for example, a golf club manufacturer can have several golf-related gifts, and a car manufacturer can have several car-related gifts, an opportunity for soliciting ads (also called acceptance ads) which is a form of advertising (gift descriptions) that participants as to see and show interest in (see also page 17). Stanbach also teaches the advertisement is based on the preference trends of the recipients (see col. 11 lines 10-22).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

  
**RETTA YEHDEGA**  
**PRIMARY EXAMINER**